

REMARKS

In the Office Action, claims 11-18 were rejected under 35 U.S.C. 101. In response, claims 11-18 have been cancelled from the application.

Claims 19 and 20 have been withdrawn from consideration in view of the earlier restriction requirement.

In addition, in the Office Action, claims 1-18 were rejected under 35 U.S.C. 102(b) or, in the alternative, under 35 U.S.C. 103(a) as obvious over U.S. Patent No. 6,193,233 to Lipman. In response, independent claim 1 has been amended to more specifically recite that the first and second dice provide a user with an option relating to consumables when both the first and second dice are simultaneously rolled. For the following reasons, Applicants respectfully submit that amended claims 1 and the claims that are dependent thereon are patentable over Lipman.

In rejecting the claims of the application, the Examiner notes that it has been held that when the claimed printed matter is not functionally related to the substrate, it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack*, 217 USPQ 401 (Fed. Cir. 1983). Applicants respectfully submit, however, that in the case of the present invention as recited by amended claim 1, the printed matter is functionally related to the substrate (the dice). More specifically, this relationship is the essence of the invention. Without the consumable information being printed on the dice, there would be no mechanism in place for a decision to be made. Rolling the dice is how the decision is made. If there was no printed information on the dice, rolling the dice would be pointless. Conversely, there is no way to make a decision if the consumable information were merely printed on a different substrate (such as a piece of paper).

Indeed, "the critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate." *In re Gulack*, 217 USPQ 401, 404 (Fed. Cir. 1983). Furthermore, "Differences between an invention and the prior art cited against it cannot be ignored merely because those differences reside in the content of the printed matter." *Id.* at 403.

As described in the specification of the application, the invention is directed to dice for choosing between options relating to consumables. More specifically, by rolling the dice of the invention, the user is provided with an option regarding a meal, drinks or an outing regarding same in a quick and entertaining manner. In addition to offering entertainment, the invention saves time and takes the worry out of selecting a location and/or consumable. For example, if a group of people are going out, no one person is stuck making the decision on where to go and the group does not have to waste time debating the decision.

In contrast to the invention recited by amended claim 1, Lipman discloses dice for simulating a multiplicity of sport games (column 3, lines 43 and 44). The dice of Lipman are designed to be used by two players who "play" against each other in the simulated sport game by rolling the dice of Lipman (column 4, lines 40 and 41). According to Lipman, a player first rolls one of the dice and, depending on the outcome of the dice roll, is required to either roll the second dice, re-roll the first dice or hand the dice over to the second player for his or her turn. As a result, the dice of Lipman may never be used simultaneously – they must be used sequentially, in contrast to amended claim 1.

The dice of Lipman therefore differ considerably from those of the present invention. The dice of Lipman have nothing to do with making a decision or selecting an option, have nothing to do with consumables and may not be used simultaneously.

Applicants therefore respectfully submit that independent claim 1 and dependent claims 2-10 are patentable over the cited references.

In view of the foregoing amendments and remarks, it is believed that the application is in condition for allowance and such action is respectively requested.

If the Examiner believes that a telephone conference would advance the prosecution of the case, it is requested that the undersigned attorney be telephoned for that purpose.

Respectfully submitted,



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